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storytelling with data, LLC

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

STORYTELLING WITH DATA, LLC, a  
California limited liability company,

Plaintiff,

vs.

TRUSTEES OF BOSTON UNIVERSITY;  
and DOES 1–50, inclusive,

Defendants.

No.

**PLAINTIFF STORYTELLING WITH  
DATA, LLC’S COMPLAINT FOR  
FEDERAL TRADEMARK  
INFRINGEMENT, FALSE DESIGNATION  
OF ORIGIN, CALIFORNIA COMMON  
LAW TRADEMARK INFRINGEMENT,  
AND CALIFORNIA STATUTORY  
UNFAIR COMPETITION**

**DEMAND FOR JURY TRIAL**

Plaintiff storytelling with data, LLC (“SWD” or “Plaintiff”), by its attorneys, for its  
Complaint in this action alleges:

**PARTIES**

1. SWD is a California limited liability company having its principal place of  
business in San Francisco, California.

2. On information and belief, the Trustees of Boston University (“Boston  
University”) is a non-profit educational institution with its principal place of business at One  
Silber Way, Boston, Massachusetts 02215.

3. SWD is ignorant of the true names of the other Defendants sued herein as Does 1–  
50, inclusive, and therefore, sues these Doe Defendants by such fictitious names. Additional Doe

1 Defendants are likely to include, among others, any other individuals or entities that have  
2 authorized, condoned, directed, or participated in the trademark infringement alleged in this  
3 Complaint, such as any individuals at Boston University who made the decision to continue  
4 infringing SWD's STORYTELLING WITH DATA trademark after being notified of such  
5 infringement by SWD. SWD will amend this Complaint to allege their true names and capacities  
6 when ascertained.

#### 7 **JURISDICTION AND VENUE**

8 4. This Court has subject matter jurisdiction of this action under 28 U.S.C. §§ 1331,  
9 1338(a) and (b), and 1367, 15 U.S.C. § 1121, as this action involves substantial claims arising  
10 under the U.S. Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.*, combined with  
11 related and supplemental claims for state trademark infringement and unfair competition.

12 5. Defendant Boston University is subject to personal jurisdiction in this district  
13 because it conducts substantial, continuous, and systematic activities in this judicial district and  
14 because SWD's causes of action contained herein arise out of or result from Defendant's contacts  
15 with this judicial district.

16 6. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) because a  
17 substantial part of the events or omissions giving rise to the claims occurred in this judicial  
18 district and SWD's intellectual property that is the subject of this action is situated in this judicial  
19 district.

#### 20 **INTRADISTRICT ASSIGNMENT**

21 7. Pursuant to N.D. Civil Local Rule 3-2(c), this is an intellectual property action  
22 subject to district-wide assignment.

#### 23 **FACTS RELEVANT TO ALL CLAIMS**

##### 24 **Plaintiff's adoption, use, and ownership of the STORYTELLING WITH DATA mark**

25 8. SWD was founded by Nicole ("Cole") Nussbaumer Knafllic, a well-known author,  
26 speaker, and leading expert in the field of communication and data visualization, and Managing  
27 Member of SWD.

28 9. Ms. Nussbaumer Knafllic is the author of the popular book titled "*Storytelling with*

1 *Data*,” published by Wiley in 2015. The book enjoys widespread distribution with over 46,000  
2 copies sold and it is a regular “#1 Best Seller” on Amazon.com across multiple categories.

3 10. In addition to her book, Ms. Nussbaumer Knafllic writes the popular “Storytelling  
4 With Data” blog, established in 2010.

5 11. For more than six years, businesses, organizations and individuals have looked to  
6 the Storytelling With Data® brand presentations, workshops and educational sessions as the  
7 premier source of training in data visualization and communication. Since 2011, Ms.  
8 Nussbaumer Knafllic and/or SWD have conducted more than 200 public and private workshops  
9 under the STORYTELLING WITH DATA mark. Customers of the STORYTELLING WITH  
10 DATA educational workshops, training services, and written materials include a wide range of  
11 high profile businesses, including eBay, Google, General Mills, Hewlett Packard, JPMorgan  
12 Chase, Microsoft, Target, Visa, and World Bank, as well as high profile educational institutions.

13 12. With regard to educational institutions, Ms. Nussbaumer Knafllic has guest  
14 lectured at numerous universities and the Storytelling With Data book is utilized in the  
15 curriculum of many educational institutions, including Stanford, Northwestern, University of  
16 Washington, Midwestern State University, Oklahoma State University, CUNY, University of  
17 North Carolina, ZHAW (Switzerland), Kellogg, Columbia, Augusta University, Pepperdine,  
18 Georgetown, and the University of New Brunswick (Canada).

19 13. Through these prestigious engagements, widespread distribution of the book, blog,  
20 and other educational materials, and through promotional efforts, consumers identify SWD and  
21 Ms. Nussbaumer Knafllic as the source of the STORYTELLING WITH DATA educational  
22 materials and services. As a result, Ms. Nussbaumer Knafllic and/or SWD own common law  
23 trademark rights in the STORYTELLING WITH DATA mark dating back to at least as early as  
24 December 9, 2010.

25 14. On January 27, 2016, Ms. Nussbaumer Knafllic filed federal U.S. application Serial  
26 No. 86/888,258 for the STORYTELLING WITH DATA trademark with the U.S. Patent and  
27 Trademark Office (“USPTO”).

28 15. On September 6, 2016, U.S. application Serial No. 86/888,258 matured into

1 federal U.S. trademark Registration No. 5,035,958 for the STORYTELLING WITH DATA  
2 trademark in connection with the following goods and services: (i) electronic publications,  
3 namely, articles, videos, presentations, documents and spreadsheets in the fields of business  
4 communications and professional development; downloadable multimedia files containing audio  
5 and video relating to business communications and professional development; video recordings  
6 featuring instruction in the fields of business communications and professional development;  
7 downloadable video recordings featuring instruction in the fields of business communications and  
8 professional development; audio and video recordings featuring instruction in the fields of  
9 business communications and professional development, in International Class 9, and (ii) on-line  
10 journals, namely, blogs in the fields of business communications and professional development;  
11 providing a website featuring blog posts and non-downloadable publications in the nature of  
12 articles, videos, presentations, documents and spreadsheets in the fields of business  
13 communications and professional development; providing on-line publications in the nature of  
14 articles, videos, presentations, documents and spreadsheets in the fields of business  
15 communications and professional development; educational services, namely, conducting  
16 workshops, seminars, webinars, classes and providing training in the fields of business  
17 communications and professional development; educational services, namely, workshops and  
18 presentations in the fields of business communications and personal development and distribution  
19 of training materials in connection therewith; educational services, namely, consulting and  
20 coaching to improve communications, messages and presentations in the fields of business  
21 communications and personal development, in International Class 41. A true and correct copy of  
22 the certificate of registration is attached hereto as **Exhibit A**.

23 16. On March 7, 2017, Ms. Nussbaumer Knafllic formed and registered SWD as a  
24 California limited liability with the California Secretary of State. Ms. Nussbaumer Knafllic is the  
25 managing member of SWD.

26 17. On March 21, 2017, Ms. Nussbaumer Knafllic assigned all right, title, and interest  
27 to the STORYTELLING WITH DATA trademark, including U.S. trademark Registration No.  
28 5,035,958, along with all the goodwill of the business associated with the STORYTELLING

WITH DATA trademark, to SWD. The assignment was recorded at the USPTO on September 8, 2017 at Real/Frame No. 6150/0839. As such, SWD now owns all common law and registered trademark rights for the STORYTELLING WITH DATA trademark.

**Boston University intentionally adopts the identical STORYTELLING WITH DATA mark**

18. Maggie Mulvihill (“Professor Mulvihill”) is an individual and faculty member at Boston University’s College of Communication. Professor Mulvihill runs the workshops at Boston University that use the infringing STORYTELLING WITH DATA mark.

19. In approximately March 2015, Professor Mulvihill reached out to Ms. Nussbaumer Knaflc, expressing her admiration for her STORYTELLING WITH DATA educational materials and workshops, and invited Ms. Nussbaumer Knaflc to speak to students at a Boston University workshop. Due to other commitments, Ms. Nussbaumer Knaflc politely declined the invitation.

20. At least by that time, Professor Mulvihill and Boston University were admittedly familiar with Ms. Nussbaumer Knaflc’s body of work and goods and services provided under the STORYTELLING WITH DATA trademark.

21. Despite being aware of Ms. Nussbaumer Knaflc’s prior long-standing use of the STORYTELLING WITH DATA mark for educational materials and services, and on information and belief, Boston University and Professor Mulvihill decided to adopt and use the identical STORYTELLING WITH DATA trademark to prominently promote and sell directly competing educational materials and services, including workshops.

22. Further exacerbating the confusion, the logos used by Boston University and SWD in connection with the STORYTELLING WITH DATA marks feature nearly identical fonts and a row of vertical bars in the center of the mark:



<https://www.bu.edu/com/data-storytelling/>

<http://www.storytellingwithdata.com/>

23. More recently, Boston University has begun offering digital badges in connection with its infringing STORYTELLING WITH DATA workshops, which feature the confusingly similar phrase DATA STORYTELLING. These badges essentially encourage students who graduate from Boston University's infringing workshops to display SWD's registered mark without authorization from SWD.

**Boston University refuses to discontinue its willful infringement**

24. On January 5, 2017, shortly after discovering Defendant Boston University's infringement, SWD sent a cease and desist email to Boston University notifying Boston University of SWD's prior rights in the STORYTELLING WITH DATA trademark and ownership of federal U.S. trademark Registration No. 5,035,958 for STORYTELLING WITH DATA and requesting that Boston University discontinue its infringing use of the identical STORYTELLING WITH DATA trademark.

25. SWD sent a follow-up email requesting a response in light of the confusion being created by Boston University's infringing use of the identical STORYTELLING WITH DATA trademark.

26. On February 13, 2017, Boston University's Associate General Counsel, Sheila O'Leary, acknowledged receipt of SWD's January 5, 2017 cease and desist email and indicated that she would send "a substantive response shortly, under separate cover."

27. On March 6, 2017, SWD still had not received a response from Boston University or Ms. O'Leary and followed up with yet another email.

28. Finally, over two months later on March 17, 2017, Boston University, through Ms. O'Leary, responded to SWD's January 5, 2017 email. Despite its clear trademark use of STORYTELLING WITH DATA, Boston University unconvincingly denied that it was infringing at least partly on the grounds that it was only using the STORYTELLING WITH DATA mark to describe its services.

29. On April 17, 2017, SWD, through its counsel Carr & Ferrell LLP, sent a letter to Boston University substantively responding to Ms. O'Leary's March 17, 2017 letter. The letter detailed SWD's prior rights in the STORYTELLING WITH DATA trademark, Boston

1 University's intentional, bad faith adoption of the identical mark and similar logo, and reiterated  
2 SWD's request that Boston University cease its infringement. The letter requested a response by  
3 May 1, 2017.

4 30. Despite requesting a response by May 1, 2017, Boston University did not respond,  
5 forcing SWD's counsel to contact and follow-up with Ms. O'Leary regarding the matter.

6 31. On June 5, 2017 Ms. O'Leary finally sent a brief email reply, and on June 8, 2017,  
7 she made herself available for an initial telephone call with SWD's counsel. However, Boston  
8 University was unwilling to discontinue its infringing use of STORYTELLING WITH DATA.

9 32. Finally, after multiple requests to discuss the matter, on August 28, 2017, Ms.  
10 O'Leary had a second telephone call with SWD's counsel. However, again, Boston University  
11 was unwilling to discontinue its infringing use of STORYTELLING WITH DATA.

12 33. On August 31, 2017, Ms. O'Leary sent an email to SWD's counsel restating the  
13 University's position on that matter and refusing to discontinue its infringing use of the identical  
14 STORYTELLING WITH DATA trademark, thereby leaving SWD with no recourse but to file  
15 the instant Complaint for trademark infringement.

16 **Boston University's infringing use of the STORYTELLING WITH DATA has created and**  
17 **continues to create a likelihood of confusion among the public**

18 34. Notwithstanding Defendant Boston University's knowledge of SWD's prior rights  
19 in the STORYTELLING WITH DATA trademark, Boston University has and is promoting its  
20 competing educational materials and services, including workshops, under the identical and  
21 confusingly similar STORYTELLING WITH DATA trademark in Massachusetts, California, and  
22 throughout the United States with the deliberate and calculated intent to trade on the goodwill and  
23 reputation symbolized by SWD's STORYTELLING WITH DATA mark to confuse and mislead  
24 the public.

25 35. Defendant Boston University's use of the identical STORYTELLING WITH  
26 DATA trademark is likely to cause confusion, cause mistake, and/or deceive consumers and the  
27 purchasing public as to affiliation, connection, or association of SWD and Boston University and  
28 as to origin, sponsorship, or approval of Boston University's services by SWD.



**FIRST CLAIM FOR RELIEF**  
**INFRINGEMENT OF A REGISTERED TRADEMARK**  
**UNDER § 32(1) OF THE LANHAM ACT (15 U.S.C. § 1114(1))**

36. Paragraphs 1–35, above, are realleged and incorporated by reference as if set forth in full.

37. Plaintiff SWD owns prior rights in the STORYTELLING WITH DATA trademark and owns federal U.S. trademark Registration No. 5,035,958 for the STORYTELLING WITH DATA trademark in connection with the educational goods and services listed in Exhibit A.

38. By virtue of the registered status of SWD’s STORYTELLING WITH DATA trademark, Defendant Boston University had constructive notice of SWD’s rights in the mark. By acting with such notice and knowledge, Boston University has willfully and deliberately infringed SWD’s trademark rights.

39. Boston University’s use of the identical STORYTELLING WITH DATA trademark in connection with highly similar, if not identical, services, namely, educational materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers and the purchasing public as to affiliation, connection, or association of SWD and Boston University and as to origin, sponsorship, or approval of Boston University’s services by SWD. In addition, Boston University’s infringement is likely to cause, *inter alia*, subliminal and associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-sale confusion, and post-sale confusion.

40. Defendant Boston University’s aforesaid acts have caused and will continue to cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this Court through a temporary restraining order, preliminary injunction, and/or permanent injunction, such acts will be continued and SWD will continue to suffer damages and irreparable injury.

**SECOND CLAIM FOR RELIEF**  
**FALSE DESIGNATION OF ORIGIN**  
**UNDER § 43(a) OF THE LANHAM ACT (15 U.S.C. § 1125(a))**

41. Paragraphs 1–40, above, are realleged and incorporated by reference as if set forth in full.



42. SWD owns common law trademark rights in the STORYTELLING WITH DATA trademark and STORYTELLING WITH DATA Design Mark (collectively the “STORYTELLING WITH DATA Marks”) in connection with a variety of educational publications and materials and a variety of educational services.

43. SWD’s trademark rights in the STORYTELLING WITH DATA Marks predate any trademark use by Boston University of the infringing identical STORYTELLING WITH DATA trademark. More specifically, SWD’s first use of the STORYTELLING WITH DATA Marks occurred at least as early as December 9, 2010.

44. Boston University’s use of the identical STORYTELLING WITH DATA trademark in connection with highly similar, if not identical, services, namely, educational materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers and the purchasing public as to affiliation, connection, or association of SWD and Boston University and as to origin, sponsorship, or approval of Boston University’s services by SWD. In addition, Boston University’s infringement is likely to cause, *inter alia*, subliminal and associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-sale confusion, and post-sale confusion.

45. Defendant Boston University’s aforesaid acts have caused and will continue to cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this Court through a temporary restraining order, preliminary injunction, and/or permanent injunction, such acts will be continued and SWD will continue to suffer damages and irreparable injury.

**THIRD CLAIM FOR RELIEF**  
**TRADEMARK INFRINGEMENT**  
**UNDER CALIFORNIA COMMON LAW**

46. Paragraphs 1–45, above, are realleged and incorporated by reference as if set forth in full.

47. SWD owns common law trademark rights in the STORYTELLING WITH DATA trademark and STORYTELLING WITH DATA Design Mark (collectively the “STORYTELLING WITH DATA Marks”) in connection with a variety of educational

1 publications and materials and a variety of educational services.

2 48. SWD's trademark rights in the STORYTELLING WITH DATA Marks predate  
3 any trademark use by Boston University of the infringing identical STORYTELLING WITH  
4 DATA trademark. More specifically, SWD's first use of the STORYTELLING WITH DATA  
5 Marks occurred at least as early as December 9, 2010.

6 49. Boston University's use of the identical STORYTELLING WITH DATA  
7 trademark in connection with highly similar, if not identical, services, namely, educational  
8 materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers  
9 and the purchasing public as to affiliation, connection, or association of SWD and Boston  
10 University and as to origin, sponsorship, or approval of Boston University's services by SWD. In  
11 addition, Boston University's infringement is likely to cause, *inter alia*, subliminal and  
12 associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-  
13 sale confusion, and post-sale confusion.

14 50. Defendant Boston University's aforesaid acts have caused and will continue to  
15 cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this  
16 Court through a temporary restraining order, preliminary injunction, and/or permanent injunction,  
17 such acts will be continued and SWD will continue to suffer damages and irreparable injury.

18 51. Defendant Boston University acted with malice, oppression, and fraud, as defined  
19 in California Civil Code § 3294, and willfully and with the intent to cause injury to SWD, thereby  
20 warranting an assessment of punitive damages in an amount appropriate to punish Defendant and  
21 to deter others from engaging in similar conduct.

22  
23 **FOURTH CLAIM FOR RELIEF**  
24 **STATUTORY UNFAIR COMPETITION**  
25 **UNDER CALIFORNIA BUSINESS & PROFESSIONS CODE § 17200 et seq.**

26 52. Paragraphs 1–51, above, are realleged and incorporated by reference as if set forth  
27 in full.

28 53. As detailed throughout this Complaint and in Paragraphs 38-40 above, Defendant  
Boston University has infringed SWD's STORYTELLING WITH DATA trademark by using the

1 identical STORYTELLING WITH DATA trademark in connection with highly similar, if not  
 2 identical, goods and services. Defendant's acts and conduct constitute "unlawful, unfair, or  
 3 fraudulent business act[s] or practice[s] and unfair, deceptive, untrue, or misleading advertising"  
 4 within the meaning of California Business and Professions Code §17200 *et seq.* Defendant's acts  
 5 and conduct are wrongful, knowing, willing, and malicious, and constitute unfair competition  
 6 under California law.

7 54. Defendant Boston University's aforesaid acts have caused and will continue to  
 8 cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this  
 9 Court through a temporary restraining order, preliminary injunction, and/or permanent injunction,  
 10 such acts will be continued and SWD will continue to suffer damages and irreparable injury.

11 55. Defendant Boston University acted with malice, oppression, and fraud, as defined  
 12 in California Civil Code § 3294, and willfully and with the intent to cause injury to SWD, thereby  
 13 warranting an assessment of punitive damages in an amount appropriate to punish Defendant and  
 14 to deter others from engaging in similar conduct.

#### 15 **PRAYER FOR RELIEF**

16 WHEREFORE, SWD prays for judgment against Defendant Boston University and relief  
 17 as follows:

18 (i) that pursuant to 15 U.S.C. § 1116 and its inherent equitable powers, the Court  
 19 issue a temporary restraining order, preliminary injunction, and permanent injunction restraining  
 20 and enjoining Defendant Boston University from using the STORYTELLING WITH DATA  
 21 mark in connection with educational materials and services, as well as any names or marks  
 22 confusingly similar to SWD's STORYTELLING WITH DATA trademark, including any marks  
 23 consisting of or containing both the terms STORYTELLING and DATA;

24 (ii) that Defendant Boston University be ordered to remove and/or deliver up for  
 25 destruction all advertisements, packaging, labels, materials, and other articles bearing the  
 26 STORYTELLING WITH DATA mark, as well as any marks that infringe SWD's  
 27 STORYTELLING WITH DATA trademark, including any marks consisting of or containing  
 28 both the terms STORYTELLING and DATA;

1 (iii) that pursuant to 15 U.S.C. § 1117(a), SWD recover Defendant Boston University's  
2 profits and such sums in addition thereto as the Court shall find just;

3 (iv) that pursuant to 15 U.S.C. § 1117(a), SWD recover the damages sustained in an  
4 amount to be proven at trial;

5 (v) that pursuant to 15 U.S.C. § 1117(a), SWD recover the costs of this action,  
6 including reasonable attorneys' fees and interest;

7 (vi) that pursuant to California Business & Professions Code § 17200 *et seq.*, SWD be  
8 awarded restitution;

9 (vii) that pursuant to California Civil Code § 3294, the Court award punitive damages  
10 against Defendant Boston University;

11 (viii) that the Court declare that Defendant Boston University's use of the  
12 STORYTELLING WITH DATA mark in connection with educational materials and services  
13 infringes SWD's trademark rights in the STORYTELLING WITH DATA mark;


14 (ix) that SWD be awarded its costs and attorneys' fees; and

15 (x) such other and further relief that this Court may deem just and equitable.

16 Dated: October 9, 2017

Respectfully submitted,

17 CARR FERRELL LLP

18  
19 By   
20 Robert J. Yorio  
21 Attorneys for Plaintiff  
22 storytelling with data, LLC  
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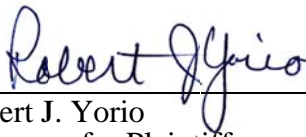
**DEMAND FOR JURY TRIAL**

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff demands a jury trial.

Dated: October 9, 2017

Respectfully submitted,

CARR FERRELL LLP

By   
Robert J. Yorio  
Attorneys for Plaintiff  
storytelling with data, LLC